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	APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
	09/749,752	12/28/2000	Taizo Akimoto	Q61244	4934
	7	7590 09/12/2002			
	SUGHRUE, MION, ZINN, MACPEAK & SEAS, PLLC			EXAMINER	
2100 Pennsylvania Avenue, N. W. Washington, DC 20037-3202			GOLDBERG, JEANINE ANNE		
				ART UNIT	PAPER NUMBER
		•		1634	
				DATE MAILED: 09/12/2002	T.

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/749,752



Applicant(s)

AKIMOTO, TAIZO

Examiner

Art Unit

Jeanine A Goldberg 1634

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.

 If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely. If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this considered timely.

- Failu - Any	ure to reply within the set or extended period for re reply received by the Office later than three montl	eply will, by statute, cause the app ans after the mailing date of this co	lication to become ABANDONED (35 U.S.C. § 133). mmunication, even if timely filed, may reduce any				
Status	ed patent term adjustment. See 37 CFR 1.704(b)	•					
1)⊠	Responsive to communication(s)	filed on <u>27 August 200</u>	<u>1</u> .				
2a) <u></u> □	This action is FINAL.	2b)⊠ This action is					
3)[Since this application is in condit	ion for allowance excep	t for formal matters, prosecution as to the merits is				
Dienoeit	closed in accordance with the pr ion of Claims	actice under Ex parte G	uayle, 1935 C.D. 11, 453 O.G. 213.				
		·					
	Claim(s) 1-11 is/are pending in the application.						
	4a) Of the above claim(s) is/are withdrawn from consideration.						
	Claim(s) is/are allowed.						
	6) Claim(s) is/are rejected.						
	Claim(s) is/are objected to						
	Claim(s) <u>1-11</u> are subject to restri	ction and/or election red	uirement.				
	ion Papers						
	9)☐ The specification is objected to by the Examiner.						
10)∐	The drawing(s) filed on is/a						
		= : :	be held in abeyance. See 37 CFR 1.85(a).				
11)	11) ☐ The proposed drawing correction filed on is: a) ☐ approved b) ☐ disapproved by the Examiner.						
	If approved, corrected drawings are	• •	fice action.				
12)	The oath or declaration is objected	to by the Examiner.					
Priority ι	under 35 U.S.C. §§ 119 and 120		,				
13)	13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).						
a)	☐ All b)☐ Some * c)☐ None o	f:					
	1. Certified copies of the priori	ty documents have bee	n received.				
	2. Certified copies of the priori	ty documents have bee	n received in Application No				
			ents have been received in this National Stage				
* <	application from the Inte See the attached detailed Office ac						
			•				
			nder 35 U.S.C. § 119(e) (to a provisional application).				
	i) \square The translation of the foreign Acknowledgment is made of a clair						
رر Attachmen		n lor domestic priority u	inder 33 0.3.0. 99 120 and/or 121.				
	e of References Cited (PTO-892)		4) Interview Summary (PTO-413) Paper No(s)				
2) 🔲 Notic	te of Draftsperson's Patent Drawing Review mation Disclosure Statement(s) (PTO-1449		5) Notice of Informal Patent Application (PTO-152) 6) Other:				

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DETAILED ACTION

Election/Restrictions

- 1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - Claims 1-3, drawn to a test piece comprising a plurality of probes, and a pattern of ID information, classified in class 435, subclass 174.
 - II. Claims 4-5, drawn to an analysis method for analyzing a target substance by bonding of a target substance to the test piece, attaching ID information and obtaining information concerning probes and detecting ID infromation, classified in class 435, subclass 6.
 - III. Claims 6-11, drawn to an analysis system comprising means for attaching management information to test piece, means for obtaining information concerning the position of the probes, means for detecting management information and means for storing the information, classified in class 435, subclass 287.1, 702/22, for example.
- 2. The inventions are distinct, each from the other because of the following reasons:
- A) Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the test piece comprising probes and ID information may be used for storing nucleic acid, purification

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of nucleic acid, hybridization assays, diagnostic assays, amplification assays or detection assays.

- B) Inventions II and III are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the method may be performed without the use of the apparatus. The apparatus requires a means for storing information, however the method may be performed with out such function.
- C) Inventions I and III are directed to a test piece and to a larger apparatus used to analyze such test piece. The test piece is Inventions I and III are patentably distinct because the test piece comprising probes and ID information are structurally and functionally distinct from the apparatus comprising means for attaching management information to test piece, means for obtaining information concerning the position of the probes, means for detecting management information and means for storing the information. Therefore these inventions are novel and unobvious over one another.
- 3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by the different classifications and their divergent subject matter, restriction for examination purposes as indicated is proper.

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- 4. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).
- 5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Jeanine Goldberg whose telephone number is (703) 306-5817. The examiner can normally be reached Monday-Friday from 8:00 a.m. to 5:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Jones, can be reached on (703) 308-1152. The fax number for this Group is (703) 305- 3014.

Any inquiry of formal matters can be directed to the patent analyst, Pauline Farrier, whose telephone number is (703) 305-3550.

Any inquiry of a general nature should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Jeanine Goldberg September 10, 2002

Supervisory Patent Examiner Technology Center 1600